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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/936,182	09/24/97	KITAGISHI N	1282-4046US1

MM11/0426

CHRISTOPHER E. CHALSEN
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EXAMINER	
SHAFER, R	
ART UNIT	**PAPER NUMBER**
2872	

DATE MAILED: 04/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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08/936,182	09/24/97	KITAGISHI	1232/40046US1

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1/25/99 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 36-105 are pending in the application.
   Of the above, claims 57-70 AND 92-105 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 36-56 are rejected.
5. ☒ Claims 71-90 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Applicant's election with traverse of species "G" depicted by Fig. 9 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that all groups of claims are properly presented in the same application and undue diverse searching should not be required. This is not found persuasive because the species requirement set forth in paper no. 7 is based on the claimed structural differences between the various species and not on their similarities. Applicant may avoid restriction by presenting an allowable linking claim or by a clear admission on the record that the nonelected species are not patentably distinct from the elected species.

Applicant's remarks, filed on 1/11/99, is an improper traversal because applicant failed to clearly admit on the record that the nonelected species are not patentably distinct from the elected species.

Thus, the election has been treated as an election without traverse. Note MPEP 818.03(a).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 57-70 and 92-105 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 8.

3. Claims 43-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide support for a right-angle prism means being disposed on one surface of a transparent plate and the slant surface of the right-angle prism means being abutted to the other surface of said transparent plate. Note page 19, line 19 to page 20, line 26.

4. Claims 43-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 43, lines 3-4, the language "right-angle...surface" is vague, indefinite and/or confusing.

It is unclear to the examiner how a right-angle prism means can possibly be disposed on one surface and the slant of said right-angle prism means be abutted to another surface.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 43 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuboi.

To the extent the claims are definite and supported by the original specification, Tsuboi discloses a polarizing device comprising a transparent plate (3) which has a polarizing beam splitting surface (2) on one surface and a reflection surface (3r) on the other surface, wherein light is incident on said one surface to be split into reflected light (R) and transmitted light (T) by

said polarizing beam splitting surface so that the transmitted light is directed to said reflection surface and a right angle prism means (11) disposed on said one surface, wherein the slant of said right angle prism means is abutted on said polarizing beam splitting surface and wherein the material employed for the polarizing beam splitting surface serves as the means for causing a polarizing state of the reflected and transmitted light. Note Fig. 2.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 37, 38, 44, 45, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuboi.

Tsuboi discloses all of the subject matter claimed, note the above explanation, except for a lens array.

It is well known to use cylindrical lens array or a fly eye lens array in the same field of endeavor for the purpose of making a plurality of light beams incident on an optical device or devices.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the polarizing device of TSUBOI to include

a lens array as is well known in the optical art in order to obtain a plurality of input/output beams.

7. Claims 39-42, 46-49 and 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuboi.

Tsuboi discloses all of the subject matter claimed, note the above explanation, except for an image generator for modulating polarized light.

It is well known to use an image generator in the same field of endeavor for the purpose of modulating polarized light.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the polarizing device of Tsuboi to include an image generator as is well known in the optical art in order modulate an input and/or output polarized light beam(s).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 36-42 and 50-56 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,751,480 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A polarizing device comprising a plate having a polarizing dividing surface on one surface of said plate and a reflecting surface disposed on the other surface of said plate, and an illuminating system for supplying a lattice-like light pattern.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. Claims 71-91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication should be directed to R.D.Shafer at telephone number (703) 308-4813.

Shafer/dc
April 21, 1999

RICKY D. SHAFER
PATENT EXAMINER
ART UNIT ~~2507~~ 2872